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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,672

06/07/2005

Kazutaka Tsuruhami

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6130

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7590

05/15/2009

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EXAMINER

MARX, IRENE

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

05/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/509,672	TSURUHAMI ET AL.	
	Examiner	Art Unit	
	Irene Marx	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/15/05, 12/3/08, 10/0/04, 12/1/04.

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DETAILED ACTION

The application should be reviewed for errors.

To facilitate processing of papers at the U.S. Patent and Trademark Office, it is recommended that the Application Serial Number be inserted on every page of claims and/or of amendments filed.

Applicant's election without traverse electing to prosecute the invention of Group I, claims 1-5 on 3/31/09 is acknowledged.

Claims 1-5 are being considered on the merits.

Claims 6-11 are withdrawn from consideration as directed to a non-elected invention.

It is noted that the microorganism(s) required to practice the claimed invention are currently available from Institute for Fermentation, Inc. and Institute of Molecular and Cellular Biosciences (Specification, page 5, paragraph 3). It appears that the microorganism(s) should remain available to the public beyond the effective life of the patent. Any information to the contrary which comes to applicants' attention during the prosecution of this application must be inserted into the record or otherwise be brought to the attention of the Office by applicants.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 fails to find proper antecedent basis in claim 1 for "the diglycosidase activity is... or more by dry weight". In claim 1 the composition is claimed as "being capable of producing diglycosidase". In addition, it is unclear what "dry weight" pertains to.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuruhami *et al.* (U.S. Patent No. 7,118,95)

The claims are directed to a composition comprising a fungus or a bacterium belonging to various genera, that is capable of producing diglycosidase, including the specific strains *A. fumigatus* IAM 2046, *A. niger* IAM 2020 and IAM 2047, and *Penicillium muticolor* IAM 7153..

Tsuruhami *et al.* discloses a composition comprising fungi or bacteria belonging to various genera, that is capable of producing diglycosidase, , including the specific strains *A. fumigatus* IAM 2046, *A. niger* IAM 2020 and IAM 2047 and *Penicillium muticolor* IAM 7153. See, e.g., col. 3, lines 19-21, col. 4, lines 42-51; col. 6, lines 36-44 and col. 6, lines 45-50. For activity, see, e.g., col. 10, lines 43-65, which appears to correspond to the range in claim 5, in the absence of evidence to the contrary..

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamamoto.*et al.* (U.S. Patent No. 7,109,014).

The claims are directed to a composition comprising a fungus or a bacterium belonging to various genera, that is capable of producing diglycosidase, including the specific strains *A. fumigatus* IAM 2046, *A. niger* IAM 2020 and IAM 2047 and *Penicillium muticolor* IAM 7153..

Yamamoto.*et al.* discloses a composition comprising a fungus or a bacterium belonging to various genera, that is capable of producing diglycosidase, , including the specific strains strains *A. fumigatus* IAM 2046, *A. niger* IAM 2020 and IAM 2047 and *Penicillium muticolor* IAM 7153. See, e.g., col. 5, lines 35-47 and Table 6. . For activity, see, e.g., col. 20, Example

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7, wherein enzyme activity is assessed. The activity appears to correspond to the range in claim 5, in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/
Primary Examiner
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